



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/522,811	10/28/2005	Yasushi Iwata	040894-7174	4726

9629 7590 01/23/2008
MORGAN LEWIS & BOCKIUS LLP
1111 PENNSYLVANIA AVENUE NW
WASHINGTON, DC 20004

EXAMINER

YEE, DEBORAH

ART UNIT	PAPER NUMBER
----------	--------------

1793

MAIL DATE	DELIVERY MODE
-----------	---------------

01/23/2008

PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary

Application No.

10/522,811

Applicant(s)

IWATA ET AL.

Examiner

Deborah Yee

Art Unit

1793

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on ____.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1 to 4 is/are pending in the application.
- 4a) Of the above claim(s) ____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) ____ is/are allowed.
- 6) ☒ Claim(s) 1 to 4 is/are rejected.
- 7) ☐ Claim(s) ____ is/are objected to.
- 8) ☐ Claim(s) ____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 28 December 2005 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. ____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date 10-28-05
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. ____.
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: ____.

DETAILED ACTION

Information Disclosure Statement

1. The information disclosure statement filed October 28, 2005 fails to comply with 37 CFR 1.98(a)(3) because it does not include a concise explanation of the relevance, as it is presently understood by the individual designated in 37 CFR 1.56(c) most knowledgeable about the content of the information, of each patent listed that is not in the English language. It has been placed in the application file, but the information referred to therein has not been considered.
2. An English translation for Taketeri Umeda et al. publication has not been provided.

Claim Objections

3. Claim 5 is objected to under 37 CFR 1.75(c) as being in improper form because it is a multiple dependent claim dependent on another multiple dependent claim, which is claim 4. See MPEP § 608.01(n).

Claim Rejections - 35 USC § 103

4. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

5. Claims 1 to 4 are rejected under 35 U.S.C. 103(a) as being unpatentable over US Patent 5,176,760 (hereinafter US'760).

Art Unit: 1793

6. Claims 1 to 4 are rejected under 35 U.S.C. 103(a) as being unpatentable over Japanese patent 03-006362 (hereinafter JP'362) or Japanese patent 04-168273 (hereinafter JP'273), cited by Applicant in IDS dated October 28, 2005.

7. The abstract of US'760, JP'362 and JP'273, each teach a stainless steel containing an ion-nitrogen-implanted layer in surface layer, which closely meets the recited claims. Even though ion-nitrogen-implanted layer is not taught as a seal function layer as recited by claim 1, such would not be a patentable consideration since using layer as a seal function would merely be Applicant's future and intended use.

8. Moreover, similar to the present invention, prior art teaches a stainless steel, in general, and therefore would include ultra-low carbon stainless steel containing carbon in an amount of 0.01% or less.

9. Although steel surface that has been dehydrogenated in advance as recited by claim 5 is not taught by prior art, such would not be a patentable consideration. Note that in a product-by-process claim, the product determines patentability and not its process steps of making. Applicant will have the burden to show that prior art product does not necessarily or inherently possess the characteristics of the claimed product, see MPEP 706.03.

10. Claims 1 to 4 are rejected under 35 U.S.C. 103(a) as being unpatentable over Japanese patent 04254577 (hereinafter JP'577).

11. The English abstract of JP'577 teaches a hard -sealing surface comprising a stainless steel nitride film formed by ion plating that closely meets the recited claims.

Art Unit: 1793

12. Prior art stainless steel contains 0 to 5% C which would encompass, and therefore include ultra-low carbon stainless steel containing 0.01% or less C as recited by claim 4.

13. Although steel surface that has been dehydrogenated in advance as recited by claim 5 is not taught by prior art, such would not be a patentable consideration. Note that in a product-by-process claim, the product determines patentability and not its process steps of making. Applicant will have the burden to show that prior art product does not necessarily or inherently possess the characteristics of the claimed product, see MPEP 706.03.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Deborah Yee whose telephone number is 571-272-1253. The examiner can normally be reached on monday-friday 6:00 am-2: 30 pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Roy King can be reached on 571-272-1244. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Art Unit: 1793

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Deborah Yee/
Primary Examiner
Art Unit 1793

/DY/